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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,602	12/29/2004	Norifumi Matsubara	U 015564-3	9481

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LADAS & PARRY
26 WEST 61ST STREET
NEW YORK, NY 10023

EXAMINER

HOOK, JAMES F

ART UNIT	PAPER NUMBER
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3754

DATE MAILED: 08/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/519,602

Applicant(s)

MATSUBARA, NORIFUMI

Examiner

James F. Hook

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/18/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

The amendment filed May 18, 2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: in claims 1, 2, and 4 changing the alloy to a "Zn-In" alloy is considered new matter where there is no support for this type of alloy, where it is also noted that this change is not properly underlined.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 2, and 4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter

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which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. As per the objection above, there is no support in the specification for the newly claimed alloy of "Zn-In" where such is considered new matter.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear with no support in the specification as to what type of alloy is a Zn-In alloy thereby rendering the claims indefinite where the scope of the claim cannot be clearly determined.

It is believed that the above changes made to the alloy were inadvertent, however, such are new matter and must be treated as such. For purposes of speedy prosecution the examiner will treat the claims as if the alloy was still a Zn-Ni alloy, however, if this is in error then applicant must provide support for the change and an explanation how the current specification supports this limitation. If the change in alloy was inadvertent then such should be corrected in any subsequent action taken by applicant.

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Usui (107) in view of Ogishi, Romann, and with the teachings of Takeuchi. The patent to Usui discloses the recited piping member comprising a metal tube 1 coated in a nickel layer 6, followed by a zinc-nickel alloy layer 3 having a thickness in an example of 3-8 microns, and a chromate layer 4, where such is a fuel tube, and that at least portions of the outer resin layer can be left off or removed at portions where connections are to be made, where such would mean the chromate layer was exposed, in support that the chromate layer can be left exposed and does not require resin see the teachings of Takeuchi which sets forth that the trivalent chromate layer can in fact be the outer most layer. The patent to Usui discloses all of the recited structure with the exception of stating the thickness of the chromate layer, using trivalent chromate, providing cups to fuel pipes to make them fuel rails, where the cups have exposed chromate, and providing an additional zinc layer on top of the zinc-nickel alloy layer. The specific thickness of the chromate layer is considered an obvious choice of mechanical expedients and would have been obvious to one skilled in the art to use routine skill and experimentation to arrive at optimum values as such is merely a choice of mechanical expedients. The patent to Ogishi discloses that it is old and well known in the art to utilize trivalent chromate when using chromate to treat metal coating layers,

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and discloses that it is old and well known in the art to provide metal substrates with coating layers including zinc, and zinc-nickel alloys and that either one layer can be provided or multiple layers of these different coating layers thereby teaching the addition of a zinc layer in combination with a zinc nickel alloy layer, and adding a chromate layer of trivalent chromate as set forth above. It would have been obvious to modify the chromate layer of Usui to be made of trivalent chromate as such is an equivalent type of chromate used to treat zinc coated metal substrates, and to provide a zinc layer in combination with the zinc nickel alloy layer as such is an alternate embodiment as suggested by Ogishi where such would provide the metal substrate layer of Usui with added protection against corrosion and premature failure thereby saving money.

The patent to Romann discloses that it is old and well known in the art to provide metal fuel pipes with cups to receive fuel injectors 2, as such is old and well known in the art. It would have been obvious to one skilled in the art to modify the tube in Usui as modified by providing cups to hold inserted fuel injectors as such is old and well known in the art as suggested by Romann and such would allow for the fuel pipe to connect to fuel injectors for delivery of fuel in a more efficient manner, where such would save money. It is considered that one skilled in the art would modify the pipe in Usui to include cups and then the coating processes would be performed so that the entire pipe were properly coated and protected, and as set forth above Usui teaches that connection portions, of which cups would be connection portions as well, can be left without an outer resin layer, thereby leaving the trivalent chromate layer exposed to inherently contact the injector.

Response to Arguments

Applicant's arguments with respect to claims 1, 2, and 4 have been considered but are moot in view of the new ground(s) of rejection. See explanation above, that Usui does teach leaving the chromate layer exposed, and as taught by Takeuchi it is possible to leave a chromate layer as the outer most layer. Therefore, once combined with the Ogishi and Romann, the patent to Usui discloses all of the limitations as set forth in the new rejection above.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents to Zdroik (535, 839, and 150), West, and Mills disclosing state of the art fuel rails and coated metal substrates.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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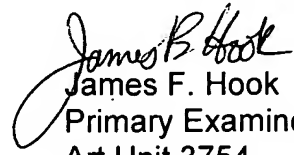
shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James F. Hook whose telephone number is (571) 272-4903. The examiner can normally be reached on Monday to Wednesday, work at home Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


James F. Hook
Primary Examiner
Art Unit 3754

JFH